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Davidson, Davidson & Kappel, LLC			EXAMINER	
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14th Floor				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,378

Applicant(s)

BACHENBERG, MICHAEL

Examiner

Meless N. Zawdu

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 35-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the communication filed on 8/14/08.
2. The sole and original claim 1 has been cancelled.
3. Claims 2-34 were cancelled in a preliminary amendment.
4. New claims, claims 35-61, are presented in this amendment.
5. Claims 35-61 are pending.

Claim Objections

Claim 49 is objected to because of the following informalities: "additional information" on line 9 should be "the additional". Appropriate correction is required.

Claim 49 is objected to because of the following informalities: "establish" on line 3 should be "establishes". Appropriate correction is required.

Claim 49 is objected to because of the following informalities: "at least one user station" on line 6 should be "at least one of the user stations". Appropriate correction is required.

Claim 49 is objected to because of the following informalities: "additional information" on lines 8-9, should be "the additional information". Appropriate correction is required.

Claim 60 is objected to because of the following informalities: "additional information" on line 9 should be "the additional information". Appropriate correction is required.

Claim 61 is objected to because of the following informalities: "least one of" on line 5 should be "at least one". Appropriate correction is required.

Claim 61 is objected to because of the following informalities: "at least one of data and additional information" should be "the at least one of the data and the additional information". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 60 recites the limitation "at least one of the communication context" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim. In other words, there was no a plurality/multiple communication context recited.

Claim 61 recites the limitation "the communication system" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 61 recites the limitation "the interface" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 35-48 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claim recites a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. must (1) be tied to another statutory category (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "clarification of "Process" under 35 U. S. C. 101"). The instance claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed steps, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 35-54 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lampela et al. (Lampela) (US 6,757,533 B2) in view of Olshansky (US 6,493,437 B1).

As per claim 35: Lampela discloses a method for a transmission of additional information in a communication system (see abstract), comprising the steps of:

transmitting a set-up signal to negotiate a communication context (to setup a call) between a first user station and a second user station, each user station having an associated user (see figs. 1-5; col. 3, lines 45-59, and wherein the set-up signal includes additional information (see col. 3, line 60-col. 4, line 8);

receiving the set-up signal including the additional information at the second user station; displaying the additional information at the second user station (see col. 5, lines 15-26; claim 37). But, Lapela does not explicitly teach about processing at least one fee-based transaction associated with at least one of the communication context and the transmission of additional information, as claimed by applicant. However, in the same filed of endeavor, Olshansky teaches about advertising, wherein during a call, at least one advertisement is displayed at a client terminal. Upon termination of the call, the service provider calculates a bill based on a subsidized rate and bills the caller (see at least, col. 2, lines 14-22). When the references are combined as shown, the bill calculation would have included the communication context (call setup) and the additional information (advertisement data). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of

Lampela with that of Olshansky for the benefit of reducing or eliminating the charges of telephone calls (see col. 1, lines 28-32).

As per claim 36: Lampela teaches about a method, further comprising the step of each user station activating a clearance to enable at least one of the transmitting and the receiving the additional information (see col. 5, lines 15-26). Note: if transmitted, it is activated and if one user does transmit/activate, so does the other.

As per claim 37: Lampela teaches about a method, further comprising the step of transmitting user information associated with the first user station to the second user station (see col. 3, lines 45-59; col. 5, lines 15-26).

As per claim 38: Lampela teaches about a method, wherein the additional information includes advertisements.

As per claim 39: Lampela teaches about a, wherein the displaying of additional information at the second user station is performed during a call signaling (see col. 5, lines 15-42).

As per claim 40: Lampela teaches about a method, further comprising the step of displaying the user information associated alternately with the additional information at the second user station (see col. 5, lines 27-42). Image, for instance, indicates the presence of a display and the various data type is an indication of displaying alternatively.

As per claim 41: Lampela teaches about a method, wherein the additional information includes an additional information model selected from a plurality of additional information models (see col. 5, lines 15-42). Each medium of Lampela's multimedia

information must have its own information model.

As per claim 42: Lampela teaches about a method, further comprising the step of inputting a code associated with the additional information to select the additional information that is to be transmitted (see 5, lines 27-42). The various message indicators of Lampela can be considered as codes.

As per claim 43: Olshansky teaches about a method, wherein the transaction includes awarding at least one bonus point to at least one of the users associated with the first user station and the second user station based on the advertisement that is transmitted (see col. 5, lines 39-55).

As per claim 44: Olshansky teaches about a method, further comprising the step of customizing the advertisement based on the location of the second user station (see col. 5, lines 39-55)..

As per claim 45: Lampela teaches about a method, wherein the user associated with the second user station can activate a filter to selectively block the transmitting of the additional information (see col. 7, lines 53-67).

As per claim 46: Lampela teaches about a method, wherein the additional information is stored in an additional information device linked to the first user station and the second user station via the communications system (see abstract). Note: the network database.

As per claim 47: Lampela teaches about a method, wherein the step of activating the clearance for receiving additional information allows the user station to transmit additional information (see col. 5, lines 15-42; col. 7, lines 3-10).

As per claim 48: Olshansky teaches about a method, further comprising the step of prompting the second user station for authorization to display the additional information prior to displaying the additional information (see col. 3, lines 1-28; col. 5, line 66-col. 6, line 7; col. 6, line 55-67).

As per claim 49: the features of claim 49 are similar to the features of claim 35, except the following which are also taught by Lampela, consider the following:

an exchange unit (see figs. 1-5, element 200; col. 5, lines 15-42); and

wherein the exchange unit establishes the communication context through a transmission of a set-up signal, the set-up signal including at least one additional information (see col. 5, lines 15-42). Therefore, claim 49 is rejected on the same ground and motivation as claim 35.

As per claim 50: Lampela teaches about an exchange device, further comprising a data processing unit linking the additional information to the communication context (call setup) (see col. 5, lines 15-42). Not: call set up is linked with multimedia, Thus, obviating the linking and processing unit.

As per claim 51: The exchange device as recited in claim 49, wherein the additional information device is configured to select at least one additional information from the plurality of stored additional information based on an identity of the user associated with the second user station (see col. 4, lines 57-58; col. 7, lines 25-39; col. 7, line 53-col. 8, line 14).

As per claim 52: Lampela teaches about an exchange device (see figs 1-5, element 200), wherein the additional information device is configured to selected at least one

additional information from the plurality of stored additional information based on at least one of a first location associated with the first user station and a second location associated with the second user station (see col. 5, lines 15-42). Note: the third provider.

As per claim 53: Lampela teaches about an exchange device, wherein the exchange device is configured to process at least one clearance associated with each user station indicating whether the user station is enabled for at least one of receiving and transmitting additional information (see figs. 1-5, element 200; col. 1, lines 15-24).

As per claim 54: Olshansky teaches about an exchange device, wherein the fee recording unit is configured to include the clearance/authorization in processing the data pertaining to fees (see at least, col. 2, lines 14-22).

As per claim 55: Lampela teaches about an exchange device, wherein the additional information includes a format of data cards (see col. 5, lines 15-42). Note: the multimedia.

As per claim 60: the features of claim 60 are similar to the features of claim 35, except claim 60 is directed to a computer readable medium intended to perform the steps of claim 35. However, since the steps of method claim 35 are obviated by the prior art of record, the computer readable medium of claim 60 must be an obvious feature within the embodiment of the prior art. There, claim 60 is rejected on the same ground and motivation as claim 35.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampela in view of Yuhn (US 6,052,440).

As per claim 56: Lampela discloses a user station for a communications system (see figs. 1-5, element 100, comprising:

an interface configured to establish a link to the communications system and at least one other user station (see figs. 1-5; col. 5, lines 15-42). The interface is apparent from the effected connection.

a data memory for storing data including at least one of image data, audio data, video data and multimedia data (see col. 5, lines 15-67, particularly lines 52-67).

a display for displaying at least one of the data and additional information (see col. 5, lines 27-42). The display is apparent from the text and/or video message.

a transmitting unit configured to transmit at least one of data and additional information over the communications system via the interface (see col. 5, lines 15-42).

But, Lampela does not explicitly teach about --- a processor unit for processing a clearance indicating whether the user station is enabled for at least one of receiving and transmitting data. However, in the same field of endeavor, Yuhn teaches about delivering a multimedia message, wherein a service control point communicates with a multimedia capability request to a service switching point associated with a destination multimedia end user terminal to determine whether the destination multimedia end user terminal is capable of servicing and playing such multimedia data; in response to which the service switching point determines the multimedia playback capabilities of the destination multimedia end user terminal and sends a report to the service control point

(see col. 5, lines 13-24; claim 7). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Lampela with that of Yuhn for the benefit of making sure that the message can be played back properly on the intended user device (see col. 5, lines 8-9).

As per claim 57: Lampela teaches about a user station, wherein the data includes a format of data cards (see col. 5, lines 15-42). Note: the multimedia.

As per claim 58: Lampela teaches about a user station, wherein the additional information includes a format of data cards (see col. 5, lines 15-42). Note: the multimedia.

As per claim 59: Lampela teaches about a user station, wherein the data and the additional information is displayed alternatingly on the display (see col. 5, lines 27-42). Image, for instance, indicates the presence of a display and the various data type is an indication of displaying alternatively.

As per claim 61: the features of claim 61 are similar to the features of claim 56, except claim 61 is directed to a computer readable medium intended to operate on the device of claim 56 so as to perform the function therein. However, since the device and its associated functions are obviated by the prior art of record, the computer readable medium of claim 61 must be an obvious feature within the embodiment of the prior art. There, claim 61 is rejected on the same ground and motivation as claim 56.

Response to Arguments

Applicant's arguments with respect to claims 35-61 have been considered but are moot in view of the new ground(s) of rejection. The new ground of rejection was necessitated by applicant's amendment of the claims. There, also, was not any argument presented regarding the rejection of the original sole claim.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bost Dwayne D can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600

/Meless N Zewdu/
Primary Examiner, Art Unit 2617
11/7/2008